

REMARKS

Claims 27-38 and 40-61 are pending in this application. Claims 36-38 and 40-51 were allowed. Claims 27-35, 52-54 and 56-60 were rejected. Claims 55 and 61 were objected.

This paper is a response to the final Office action (Paper No. 7) mailed February 12, 2003, and to the Advisory action (Paper No. 9) mailed May 30, 2003.

In the Advisory action, the examiner stated that the applicant's Reply filed on 9 May 2003 has overcome the 112, second paragraph rejection of Paper No. 7.

Claims 27 and 52 have been amended. No new matter has been added.

II. Claim Rejections - 35 U.S.C. §103

Claims 27-30, 32-35, and 52-54 stand rejected under 35 U.S.C. 103(a) as being unpatentable over MacLean (U.S. Patent No. 5,771,778) in view of Watkins (U.S. Patent No. 5,591,409).

Claims 31 and 56-60 rejected under 35 U.S.C. 103(a) as being unpatentable over MacLean '778, in view of Watkins '409, as applied above, and further in view of Burns (U.S. Patent No. 5,062,272).

1. Claims 27 and 52

(1) In response to the examiner's argument that the aroma in claims 27 and 52 is not produced by the food to be cooked, the examiner asserted that the aroma in claims 27 and 52 can be the food's natural aroma produced by the food itself and that, when a food is selected to be cooked,

as done by MacLean at column 9, lines 11-20, that food's natural aroma has also been inherently selected.

The applicant's argument regarding "aroma" is expressly incorporated in claims 27 and 52 by inserting the limitation of "said aroma not being produced by the food to be cooked."

Therefore, claims 27 and 52 are patentable.

The amendments on claims 27 and 52 place the independent claims 27 and 52 either in condition for allowance or in better form for appeal. The entry of the amendment is respectfully requested.

(2) The combination of the references

In response to the applicant's Reply filed on 12 May 2003, the examiner asserted that there is some teaching, suggestion, or motivation to combine or modify the teachings of the prior art to produce the claimed invention either in the references themselves or in the knowledge generally available to one or ordinary skill in the art.

When the incentive to combine the teachings of the references is not readily apparent, it is the duty of the examiner to explain why combination of the reference teachings is proper. Ex parte Skinner, 2 USPQ2d 1788, 1790 (Bd. App. & Int'l 1986).

In the Reply filed on 9 May 2003, the applicant argued that the examiner did not meet the burden of explaining why combination of the reference teachings is proper. In the Advisory action, the examiner did not show the desirability, but merely stated that the claimed invention is within the capabilities of one of ordinary skill in the art. "The mere fact that it is possible to find two isolated

disclosures which might be combined in such a way to produce a new compound does not necessarily render such production obvious unless the art also contains something to suggest the desirability of the proposed combination.” (*In re Bergel*, 292 F.2d 955, 956-57, 130 USPQ 206, 208 (CCPA 1961))

The applicant respectfully asks the examiner to consider the applicant’s Reply filed on 9 May 2003 regarding the “desirability” and to explain why combination of the reference teachings is proper.

The arguments of the Reply filed on 9 May 2003 regarding the desirability of the combination are incorporated herein. For the examiner’s convenience, some of the arguments are repeatedly presented.

The applicant argued in the Reply filed on 9 May 2003 that the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose.

As a marketing system, when it sells popcorn, not only the aroma of the popcorn itself but also the visual display in the popping chamber of popcorn being popped is important for drawing the passing customers. Accordingly, it is not desirable to replace the display with the parts chamber of Watkins ‘409. Also, the examiner stated in the office action that “how could aroma more directly “correspond” to a food, than to have that food’s natural aroma” (page 6, lines 3-4 on the final Office action). That is, the examiner implicitly admitted that it is not desirable to have the aroma selection and mixing step when a natural food’s aroma is generated while the food is being cooked. Also, the examiner stated that MacLean ‘778 did not disclose the aroma selection, but Watkins ‘409 did disclose the aroma selection. Why is the additional step of selecting the aroma corresponding to the

food to be cooked needed when the aroma food itself is more efficient to attract customers? Or why is the additional structure of Watkins '409 needed in the marketing machine if the food itself generates the aroma? The examiner cannot argue that when nonaroma food is selected, the aroma selection and the aroma mixing are needed. The purpose of the marketing machine in MacLean '778 is for attracting passing customers. After the payment was made, the marketing machine does not have to have an additional step and equipment of selecting an aroma and mixing an aroma corresponding to the food selected by the customer. Since it is not proper under 35 U.S.C. 103 to modify a prior art in a manner which would destroy that aspect on which the invention of the prior art patent was based. Ex parte Hartman, 186 USPQ 366, 367 (PTO Bd. App. 1974).

Accordingly, the examiner's conclusion of obviousness is not proper.

Therefore, allowance of the claims is respectfully requested.

2. With respect to claims 28-30 and 32 to 35

First, claims 28-30 and 32-35 depend from claim 27 so that these dependent claims include the limitations of claim 27. Since the applicant has presented above reasons why independent claim 27 is patentable, claims 28-30 and 32-35 are also patentable.

Second, the rejection is improper since the examiner fails to establish a *prima facie* case because all the claim limitations are not taught or suggested by the prior art.

In rejecting claims 28-30 and 32, the examiner further states that the step of diffusing the aroma before cooking is disclosed at column 9, line 25, the step of intermittent diffusion at column

9, lines 25-28, and the terminating diffusion after cooking by grinding the unused popcorn at column 9, line 29-31 on MacLean '778.

The disclosure in column 9, lines 25 to 31 on MacLean '778 discloses that a few kernels are periodically popped, regardless of whether payment has been inserted in the payment receptacle. That is, this disclosed step is made without the step of making a selection of a cooking menu for cooking food and irrespective of the selection of the food to be cooked. Because it is not possible to know which food is to be cooked without the step of selecting food to be cooked, the aroma recited in the disclosure at column 9, lines 25 is not the aroma corresponding to the food to be cooked. On the other hand, the step in claim 28 of the present application claims diffusing said aroma "corresponding to said food" to be cooked before said food is cooked.

In rejecting these claims, the examiner picks the aroma which is different from the aroma recited in rejecting claim 27, while the aromas in claims 27 and 28 of the present invention are claimed as the same. In other words, the examiner simply engaged in a hindsight reconstruction of the claimed invention, using the present invention as a template, and picking and choosing elements from references to fill the gaps.

Therefore, withdrawal of the rejection is respectfully requested.

3. With respect to claims 53 and 54

Claims 53-60 depend from claim 52 so that claims 53-60 include the limitations of claim 52. Since the applicant has presented above reasons why independent claim 52 is patentable, claims 53-60 are also patentable.

4. Claims 31 and 56-60

Claims 31 and 56-60 stand rejected under 35 U.S.C. 103(a) as being unpatentable over MacLean '778, in view of Watkins '409, as applied above, and further in view of Burns (U.S. Pat. No. 5,062,272).

First, reconsideration of the rejection of claims 31 and 56-60 is also respectfully requested because the applicant has presented above reasons why claims 27, 30 and 52 are patentable and claims 31 and 56-60 depend effectively from claims 27, 30 and/or 52.

Second, at least Burns '272 is nonanalogous art because of the reason argued in the Reply filed on 9 May 2003.

The examiner asserted in the Advisory action that Burns is directed to a food storage device which can remove unwanted odors and replace them with a fruit scent.

The field of a food storage device is not within the cooking apparatus field.

In addition, the present specification clearly states one of the purposes of the present invention: "an aroma generating device for diffusing a variety of aromas corresponding to a selected food in order to stimulate the user's appetite while the user is waiting the food cooked." (Page 3, lines2 to 3). On the other hand, Burns '272 is for overcoming possibly noxious or stale food odors that may be coming from a refrigerator or freezer. It cannot be said that Burns '272 is reasonably pertinent to the purpose or solution of the present invention only because Burns '272 includes the deodorizing step.

Therefore, Burns'272 is not within the appropriate scope of the inventor's art.

Third, even if Burns '272 is analogous art, there is no suggestion or motivation to make the proposed modification.

The examiner asserted that, it would have been obvious to one of ordinary skill in the art to deodorizing and scent replacement of Burns'272 into the invention of MacLean '778 since both are directed to aroma generating methods, and since consumers have different tastes and preferences for aromas and their interest can be increased by substituting a more pleasing aroma for the original.

MacLean '778 relates to a marketing system, and clearly states that “[t]he aroma of popcorn draws shoppers to lower traffic areas of a retail establishment” (column 25-27), and that “[t]he few sacrificial kernels are sufficient to produce the aroma of popcorn to attract passing shoppers” (column n 9, lines 28). The examiner should be noted that the purpose of the marketing machine of MacLean '778 is to promote the sales of the products in the marketing machine.

If the user selects a popcorn, why does the machine deodorize the popcorn aroma (*i.e.*, “a food aroma produced from the food cooked” in claim 31), which can attract passing customers? Also, where the machine cannot know the next customer's taste and preference, why does the marketing machine deodorize the aroma which has been already generated and still attracts the customers? Conclusively, the ordinary skilled person in the art will not install the deodorizer in the marketing machine.

In the Advisory action, the examiner did not respond to the applicant's argument regarding the desirability of “deodorizer.”

When the incentive to combine the teachings of the references is not readily apparent, it is the duty of the examiner to explain why combination of the reference teachings is proper. Ex parte Skinner, 2 USPQ2d 1788, 1790 (Bd. App. & Int'l 1986). Accordingly, the examiner should explain why the marketing machine needs a deodorizer, or how the marketing machine can know the next customer's taste and preference.

5. Claims 55 and 61

The examiner stated that claims 55 and 61 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Reconsideration of the rejection of claims 55 and 61 is also respectfully requested because the applicant has presented above reasons why claims 54 and 60 are patentable, and claims 55 and 61 depend effectively from claim 54 or 60.

In view of the above, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

A fee of \$410.00 is incurred by filing of a petition for two-month extension of time. Applicant's check drawn to the order of the Commissioner accompanies this Amendment. Should the check become lost or detached from the file, the Commissioner is authorized to charge Deposit

Account No. 02-4943 and advise the undersigned attorney accordingly. Also, should the enclosed check be deemed to be deficient or excessive in payment, the Commissioner is authorized to charge or credit our deposit account and notify the undersigned attorney of any such transaction.

Respectfully submitted,



Robert E. Bushnell,
Attorney for the Applicant
Registration No.: 27,774

1522 "K" Street N.W., Suite 300
Washington, D.C. 20005
(202) 408-9040

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